

REMARKS

This is in full and timely response to the above-identified Office Action. The above listing of the claims replaces all prior versions, and listings, of claims in the application. Reexamination and reconsideration in light of the proposed amendments and the following remarks are respectfully requested.

Specification

In this response, the abstract and specification have been amended to improve syntax and form and to introduce suitable headings and paragraph numbers into the specification.

Claim Amendments

In this response, the claims have been reviewed and amended in a manner which improves syntax and form. None of the changes constitutes a narrowing amendment.

Rejections Under 35 U.S.C. § 102

- 1) The rejection of claims 1-10, 13-26, 29-42, 45 and 46 under 35 U.S.C. § 102(b) as being anticipated by Khello (USP 5,724,423), is respectfully traversed.

The method which is recited in claim 1 calls for establishing communication between the personal communication device and the digital device, the digital device requesting a secret from the personal communication device, the personal communication device requesting confirmation from a user that the secret can be provided, and providing the secret to the digital device only if the confirmation is provided by the user.

It is submitted that these steps are not disclosed in the Khello reference which, as set forth at col. 6, lines 20-30, indicates that a user uses a portable user authentication coating device which includes an on/off key to enable/disable the authentication service in which it is such that the user is prompted to either key-in or audibly enter a PIN. After the entry of the PIN, the user presses the END button to

initiate encoding and transmission to the user authentication device center. This section of the Khello reference also indicates that the user device is preferably compact and can be carried and manipulated with one hand as well as fit into a shirt pocket or wallet.

Inasmuch as the user device requires the PIN to be entered either audibly or manually such as through a key pad, indicates that the PIN is not memorized in the user device. Further, the fact that the user must initiate encoding and transmission via pressing the END button further highlights the difference between the claimed subject matter and that which is disclosed in the Khello reference.

In a nutshell, the Khello reference fails to disclose the claimed requirements that the personal communication device requests confirmation from the user that the secret can be permitted to be sent, and also fails to disclose that the secret *per se* is initially stored in the communication device.

It is respectfully submitted that the teachings of this reference fail to establish a *prima facie* case of anticipation in that the above-mentioned method steps are not disclosed.

- 2) The rejection of claims 1, 17 and 33 under 35 U.S.C. § 102(b) as being anticipated by Hayashi et al. (GB 2,324,682A), is respectfully traversed.

First, the rejection cites only reliance upon the reasons provided in the British Search Report issued on Application # GB 0031428.6) dated 9/12/2001, as submitted by the applicant on 12/21/2001 as part of an IDS. This reliance on this British Search Report is seen as failing to fully meet the requirements that the Examiner point out where in the reference the disclosure of each of the claimed steps can be found.

Rejections under the 35 USC § 102 statute, are based on the premise that to anticipate a claim, each and every element of the claim must be shown in a single reference. When a claimed element cannot be found in the reference, the reference does not anticipate the claimed invention. Further, it is incumbent upon the Examiner to identify where in the reference each element may be found. Ex

parte Levy, 17 U.S.P.Q.2d 1461 (Bd. Pat. App. Infr. 1990).

Consequently, when the Examiner fails to identify a claimed element, the Examiner has failed to establish a *prima facie* case of anticipation.

That is to say, the terse comments set forth in the Search Report which is relied upon, merely indicate that this reference is a document indicating a lack of novelty or inventive step and makes a very generalized indication which is apparently intended to indicate that all of the claimed subject matter is disclosed at page 9, line 11-page 11, line 12.

A review of the above-mentioned section of this reference indicates that the claim steps are not disclosed. More specifically, this section of this reference discloses that when a mobile terminal MT is located in a radio zone of a nearby base station BS, and requests connection establishment to the host computer, the processor of the mobile terminal MT produces a connection establishment request signal which conveys the necessary information for communication with the host computer. This "necessary" information which is transmitted to the host computer in the initial stages of establishing communication, includes subscriber name authentication information, encryption information and an access card code. Only when the subscriber name information and the authentication information has been verified by a processor of the host computer does the host computer transmit to the mobile terminal. This is disclosed as establishing a connection between the mobile terminal and the host computer.

However, as will be noted, at no time is the user requested to confirm permission that the secret information may be permissibly provided. That is to say, the initial transmission to the host computer actually contains this secret information and the confirmation step which is recited in claim 1, is never implemented/considered.

Therefore, this reference does not contain any disclosure that anticipates the claimed subject matter and that a *prima facie* case of anticipation has not been established.

- 3) The rejection of claims 1, 17 and 33 under 35 U.S.C. § 102(a) as being anticipated by Tuneld et al. (WO 00/31608), is respectfully traversed.

This reference, on page 4, lines 12-18, indicates that when a mobile telephone is powered ON, the user is prompted for a PIN which would allow the user to operate the telephone. If the PIN entered by the user matches the PIN stored in a memory (SIM) which has been previously inserted into the mobile telephone, then the user is able to operate the mobile telephone. However, while the PIN data is actually stored in the mobile telephone, the steps which are recited in the claims are not disclosed. That is to say, the steps wherein communication is established between the personal communication device and the digital device, which prompts the digital device to request secret information from the personal communication device is not disclosed. Further, the step wherein the personal communication device requests confirmation from the user that the secret information can be permissibly provided to the digital device, is not disclosed, and most certainly the step of providing the secret information only if the confirmation is provided by the user, is not disclosed.

It is respectfully submitted that a prima facie case of anticipation has not been established and the rejection is accordingly traversed for at least this reason.

- 4) The rejection of claims 1, 17 and 33 under 35 U.S.C. § 102(a) as being anticipated by Kataoka (GB 2,341,061A), is respectfully traversed.

Again, the above mentioned Search Report is relied as the sole indication of where the anticipating disclosure is to be found in this reference. For at least the reason that the Search Report cites "the whole document", the rejection is seen as being untenable in that the burden to point out the "portions" of the reference wherein the claimed steps/elements are disclosed, has not been met.

Further, a review of this reference indicates that it discloses a portable data communication terminal and an associated user authentication device which are communicated by radio. When a user attempts to log the terminal onto a host, the terminal sends a challenge to the authenticating device which replies with a coded response. If a correct response is received, the user's identity is verified and the login is allowed. Clearly, this bypasses the step of the personal communication device requesting confirmation from a user that the secret can be permissibly provided and

transmitted to the digital device which has requested the same. Without disclosure of this step, a *prima facie* case of anticipation cannot be established.

Rejections Under 35 U.S.C. § 103(a)

The rejection of claims 11, 12, 27, 28, 43 and 44 under 35 U.S.C. § 103(a) as being unpatentable over Khello in view of Hayashi et al., is respectfully traversed.

These rejections fall with the failure of Khello to anticipate the claims from which claims 11, 12, 27, 28, 43 and 44 depend. In addition, the rejection is untenable in that it is founded on an incorrect understanding of the operation of both Khello and Hayashi et al. vis-à-vis the claimed subject matter.

Conclusion

It is submitted that the claims as they stand before the PTO are allowable over the art of record for at least the reasons advanced above. Favorable reconsideration and allowance of his application is courteously solicited.

Respectfully submitted,

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